

REMARKS

This application has been reviewed in light of the Office Action dated November 28, 2006. Claims 1-16 are now pending in this application. Claim 16 has been added. Claims 1, 2, and 6 are in independent form.

Applicants note with appreciation the allowance of Claims 6-12.

Claims 1-15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action states:

Independent Claims (1 & 2) are indefinite because the claimed preamble and the body of the claims seems to convey different scopes, i.e., the preamble is directed to a method for decoding and the body seems to list steps for a mathematical algorithm per se. Therefore the claims as presented are not clear as required by the statutes.

Applicants respectfully traverse. In a telephone interview conducted between the Examiner and the undersigned attorney, it was explained to the Examiner that the claimed steps are indeed part of the decoding method, because these steps are clearly applied to matrices derived from the received word to be decoded (see, for example, the recitation in Claim 1 of “elements S_{ij} of each line i are calculated, for j between 1 and $w(i)$, wherein boundary w is a decreasing function, using syndrome s of the received word”). The Examiner tentatively agreed during the telephone interview to withdraw the rejection under Section 112, second paragraph. Accordingly, such withdrawal is respectfully requested.

Claims 1-15 were rejected under 35 U.S.C. § 101, as being directed to non-statutory subject matter. The Office Action states:

Claims 1 to 5 and 13 to 15 are rejected under 35 U.S.C. 101 because the language of the independent claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technology art, environment or machine which would result in a practical application producing a concrete, and useful result to form the basis of statutory subject matter under 35 U.S.C. 101.

First, in a telephone interview between the Examiner and the undersigned attorney on February 27, 2007, the Examiner stated that if a claim were added reciting that the method of decoding according to Claim 1 is performed by a decoding device, the Examiner would withdraw the rejection under Section 101. Applicants have so added Claim 16. Nevertheless, Applicants do not concede the propriety of the rejection. Applicants submit that data decoding is not an abstract idea, and that nothing in the statutes or the regulations indicates that implementation by a machine is required. The Examiner is respectfully requested to cite authority supporting her position, if the Section 101 rejection is maintained.

To meet the requirements of 35 U.S.C. § 101, “[t]he claimed invention as a whole must accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’” M.P.E.P. § 2106(II)(A) (quoting *State Street Bank & Trust v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998)).

Claim 1 recites a method of decoding a one-point algebraic geometric code.

It is submitted that the claimed method, which uses a syndromes matrix S to identify a position of errors in a received word to be decoded, is statutory, because the method includes a practical application of a mathematical calculation to produce a “useful, concrete and tangible result”, i.e., a decoded word which (for example) may then be transmitted.

Moreover, as noted above, the Examiner has rejected Claims 1-5 and 13-15 as non-statutory for supposedly being directed to an abstract idea that is not tied to “a technology art.”

Although no authority is cited for the proposition that 35 U.S.C. § 101 requires the claims to involve “a technology art,” Applicants presume that the Examiner is applying the holding of cases such as *Ex Parte Bowman*, 61 U.S.P.Q.2d 1669 (Bd. Pat. App. & Int. 2001) (non-precedential). However, the U.S. Court of Appeals for the Federal Circuit has never held this to be a requirement under 35 U.S.C. § 101 and did not mention such a requirement in its most important cases addressing statutory subject matter, such as *State Street Bank & Trust v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Comm.*, 172 F.3d 1352 (Fed. Cir. 1999).

The Board of Patent Appeals and Interferences has recently recognized that the “technological arts” test is without basis in the law:

Our determination is that there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under 35 U.S.C. § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained.

Ex Parte Lundgren, 76 U.S.P.Q.2d (BNA) 1385, 1388 (Bd. Pat. App. & Int. 2005) (per curiam) (precedential). Moreover, the Board in *Lundgren* expressly noted that *Bowman* is a

non-precedential opinion without binding authority, thereby effectively overruling *Bowman*.
Id. at 1387.

Additionally, the U.S.P.T.O. has issued new interim guidelines entitled "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" which were signed on October 26, 2005 by Commissioner Doll. These guidelines can be found on the U.S.P.T.O. website at:

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Annex III on page 42 of these guidelines entitled "Improper Tests For Subject Matter Eligibility" states that the so-called "not in the technological arts" test is not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter, because "Title 35 of the United States Code does not recite, explicitly or implicitly, that inventions must be within the 'technological arts' to be patentable." The Examiner's attention is also directed to MPEP § 2106(IV)(D), which refers to Annex III for "further discussion of case law defining the line between eligible and ineligible subject matter, as well as a summary of improper tests for subject matter eligibility..."

For all the foregoing reasons, Claim 1 is believed to be directed to statutory subject matter.

Claim 2 is believed to be directed to statutory subject matter for similar reasons.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of

the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, all of the claims believed to be in condition for allowance, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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